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EXAMINER

TENG, S

ART UNIT

PAPER NUMBER

9

18M1/0223

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1812

DATE MAILED:

02/23/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.
for restriction only
A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1 - 30 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims 1 - 30 are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____ Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-10 and 26-28, drawn to polynucleotides encoding MKK proteins, classified in Class 435, subclass 69.1 and Class 536, subclass 23.1.

Group II. Claims 11-13, drawn to antisense molecules, classified in Class 536, subclass 24.3.

Group III. Claims 14-22, drawn to MKK polypeptides, classified in Class 530, subclass 350.

Group IV. Claims 23-25, drawn to antibodies specific for MKK proteins, classified in Class 530, subclass 387.1.

Group V. Claims 29 and 30, drawn to a method of inhibiting signal transduction, classified in Class 435, subclass 6.1.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products appear to constitute patentably distinct inventions for the following reasons:

Inventions I, II, III, and IV are directed to physically and functionally distinct products; therefore, they are patentably distinct inventions wherein each is not required one for the other. The protein can be prepared by materially different

processes other than transcription and translation of the encoding nucleic acids, such as chemical synthesis or isolation and purification from its native source. The antibodies of Group IV can be used not only to isolate MKK proteins but also to identify the MKK proteins in various diagnostics immunoassays. In addition to using the DNA of Group I to express the protein, the DNA can be used as a probe for screening tissues. The antisense molecules of Group II can be used to inhibit the expression of the MKK proteins and as a therapeutic agent in gene therapy. Moreover, the proteins can be used as therapeutic agents or a diagnostic agents. The antisense molecules can serve as agents for inhibiting the expression of the MKK proteins.

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as to localize the expression of the protein in various tissues.

The method of Invention V and the products of Inventions II-IV are patentably distinct inventions. The method steps of Invention V do not require the products of Inventions II-IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and their divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to attorney Laura Coruzzi on January 22, 1996, to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant's attorney specifically requested a written restriction.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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Any inquiry concerning this communication should be directed to Sally Teng, Ph.D., at telephone number (703) 308-4230. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. Draper, can be reached at telephone number (703) 308-4232.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-0294.


Sally Teng
Art Unit 1812
February 16, 1996